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III. Remarks and Conclusion

Previously, in the preliminary amendment of October 22, 2003, Applicants elected a species of benzyl β -alaninate or a salt thereof for prosecution with a species of Group II. No action has been taken on the case and the election has not been entered. Accordingly, Applicants would like to withdraw their election of Group II and traverse the restriction requirement made in the parent case. However, Applicants still choose a species of benzyl β -alaninate or a salt thereof for prosecution.

The Restriction Requirement made in the parent case is attached as Exhibit A to this Preliminary Amendment, for the Examiner's convenience.

Applicants contend that Groups I and II and Groups II and IV should be rejoined. The only difference between Group I and Group II is that the amine scavenger "is used for deprotection" and "is not used for deprotection." Likewise, the only difference between Group III and Group IV is that the thiol scavenger "is used for deprotection" and "is not used for deprotection." A search comprising the scavengers being used for deprotection or not used for deprotection would not be burdensome on the Examiner and would be economical for the patent office resources because the inventions are not independent and distinct.

There are two requirements for a proper restriction to be issued. First, the inventions must be independent or distinct as claimed. See MPEP §802.01. Second, there must be a serious burden on the Examiner to search the invention. See MPEP §803.02.

MPEP §802.01 provides the definitions for independent and distinct. Independent is defined

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as 'not dependent,' that there is no relationship between the two or more subjects disclosed, they are unconnected in design, operation or effect. The term distinct means that two or more subjects as disclosed are related and are patentable over each other. Here, Applicants contend that there is the inventions are neither independent nor distinct.

The Examiner's reasons for restriction of Groups I-IV is that each of the methods is different because they use different steps. (See Restriction Requirement of USSN 10/199,805, attached as Exhibit A). The Examiner's sole difference is that in Groups I and III the scavenger is 'used for deprotection,' while in Groups II and IV the scavenger 'is not used for deprotection.' The Examiner contends that these are different steps. Applicants assert that an application of the standard for restrictions to the inventions of the present application establishes that restriction is not proper as to whether or not the scavenger is used for deprotection. Applicants are not arguing the restriction between the amine and thiol compounds, or as to Group V, a mixture of peptides. Applicants solely are asserting that the Restriction Requirement should be rescinded as to Groups I and II and then again as to Groups II and IV.

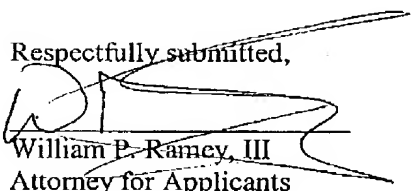
No further step is required when the scavenger is also used for deprotection compared to when the scavenger is not used for deprotection. Accordingly, the Examiner's premise for making the restriction was incorrect and the restriction not proper. Whether the scavenger acts to deprotect is a property of the scavenger and not a step being added. Accordingly, Applicants respectfully request that the requirement be rescinded.

Should the Examiner have any questions, Applicants respectfully invite the Examiner to

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contact the Applicants' attorney, William P. Ramey, III, at 302-933-4034. The application is believed in a condition for allowance and such action is respectfully requested. The Commissioner is hereby authorized to charge any required fees and to credit any credits to deposit account no. 02-2334.

Respectfully submitted,



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